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Attorney Docket No. GENO200.1/CIP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: MESSIER

SERIAL NO.: 10/079,042

FILED: FEBRUARY 19, 2002

TITLE: METHODS TO IDENTIFY
EVOLUTIONARILY SIGNIFICANT
CHANGES IN POLYNUCLEOTIDE
AND POLYPEPTIDE SEQUENCES IN
DOMESTICATED PLANTS AND
ANIMALS

EXAMINER: HORLICK, K.R.

ART UNIT: 1637

CONF NO.: 5992

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

An Office Action was mailed in the above-captioned application on May 14, 2004. In such Office Action claims 1-78 were pending. Claims 1-78 were subject to restriction and/or election requirement. This Response to Restriction Requirement document is submitted in response to said Office Action.

Restriction Requirement under 35 U.S.C. § 121

An election requirement was made to pending claims 1-26. The claims were placed into four groups:

Group 1 (claims 1-30) drawn to methods of identifying a polynucleotide;

Group 2 (claims 31-36, 45-50, and 53, drawn to EG307 polynucleotides and related products;

Group 3 (claim 51, 52, and 54-56) drawn to methods of providing increased or controllable yield in a plant;

37 CFR 1.8

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450 on 7/14/04

Signature:

Name: Tasha L. Cove

Group 4 (claims 57-65) drawn to methods of isolating yield-related genes using EG307 nucleic acid sequences.

Group 5 (claim 66) drawn to a polynucleotide of various SEQ ID NOs;
Group 6 (claim 67) drawn to a polynucleotide of various SEQ ID NOs;
Group 7 (claim 68) drawn to a polynucleotide of various SEQ ID NOs;
Group 8 (claim 69) drawn to a polynucleotide of various SEQ ID NOs;
Group 9 (claim 70) drawn to a polynucleotide of various SEQ ID NOs;
Group 10 (claim 71) drawn to a polynucleotide of various SEQ ID NOs;
Group 11 (claim 72) drawn to a polynucleotide of various SEQ ID NOs;
Group 12 (claim 73) drawn to a polypeptide of various SEQ ID NOs;
Group 13 (claim 74) drawn to a polypeptide of various SEQ ID NOs;
Group 14 (claim 75) drawn to a polypeptide of various SEQ ID NOs;
Group 15 (claim 76) drawn to a polypeptide of various SEQ ID NOs;
Group 16 (claim 77) drawn to a polypeptide of various SEQ ID NOs; and
Group 17 (claim 78) drawn to a polypeptide of various SEQ ID NOs;

Applicant hereby elects to prosecute the invention of Group 2, claims 31-36, 45-50, and 53.

As stated in MPEP § 803, “[t]here are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent ... or distinct as claimed...; and (B) There must be a serious burden on the examiner if restriction is required....”.

Applicants respectfully disagree that an examination or search of two or more inventions would constitute a serious undue burden on the Examiner. Groups 5-10 are directed to various EG307 polynucleotides (see specification, page 39-52). Since the search of Group 2, directed to EG307 polynucleotides and related products, would necessarily be coextensive with the search of EG307 polynucleotides of Groups 5-10, Applicant submits that the search of Groups 2 and 5-10 together should not constitute a serious undue burden on the Examiner.

Applicants therefore submit that restriction among Groups 2 and 5-10 is improper and respectfully request examination of claims 31-36, 45-50, 53, 66-71.